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EXAMINER	
SHAH, MILAP	

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/935,104	BRYANT, NATALIE	
	Examiner	Art Unit	
	Milap Shah	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the amendment received on August 1, 2007. The Examiner acknowledges that no claims have been amended, canceled, or added. Therefore, claims 1-8 remain pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff et al. (U.S. Patent No. 6,471,208) in view of Nagao (U.S. Patent No. 5,423,539).

Claims 1 & 6-8: Yoseloff et al. disclose the invention substantially as claimed including:

a display means (figure 2); and

a game control means arranged to control images display on the display means, the game control means being arranged to play a spinning reel game wherein at least one random event is caused to be displayed on the display means, and if a predefined winning event occurs, the machine awards a prize (abstract & column 3, lines 59-65), wherein the display means displays a plurality of spinning reels, each reel carrying symbols from a set of symbols, one of the symbols of the set of being a special symbol (column 4, lines 36-59).

Yoseloff et al. explicitly lack disclosing any specific arrangement of scatter or special symbols on the reels used by their gaming device, and more specifically, lack disclosing that "in respect of at least one of the reels, the set comprising a plurality of the special symbols, the

positions of at least certain of the special symbols on the at least one reel being separated from each other on the reel by no more than one other symbol position, so that, when more than one of the special symbols of the at least one reel are displayed simultaneously with special symbols on any of the other reels when the reels are in rest condition, all of the displayed special symbols contribute to a single paying combination of the special symbols." Yoseloff et al., however, do disclose that a "scatter pay" feature pays for the occurrence of at least 3 "special symbols" anywhere on the 5x3 matrix of symbols displayed by their gaming machine, thus, providing for the possibility that a single reel is capable of having more then one scatter symbol, if the designer of the gaming device desires such an arranged. Nagao teaches various reel strips useable in a slot or gaming machine. In figure 6A, at least on "Reel 2" and "Reel 3", the occurrence of the "1 BAR" symbol appears to be "separated from each other on the reel by no more than one other symbol position".

In the instant application, the applicant refers to specific symbols located on a reel strip as a "scatter symbol" or a "special symbol". The Examiner interprets this as mere intended use, since the scatter symbol or special symbol is just another indicia on the reel strip similar to any other indicia on the reel strip, as seen in applicant's figure 3. The labeling of these symbols as scatter or special symbols is only necessary for the pay table and for how awards are issued, such as when three of these scatter or special symbols appear anywhere on the reels. Yoseloff et al. disclose such a feature as described above, and thus, the only remaining difference between Yoseloff and the instant claims, appears to be the arrangement of indicia on a reel strip. However, as described above, Nagao discloses such an arrangement, in which the "1 BAR" symbol is easily replaceable by any other symbol to be referred to as a special symbol if so desired. Even in it's current state, the reel strips of Nagao can be implemented on the gaming machine of Yoseloff et al., where the "1

BAR" symbol may be labeled as the special symbol, thus, there is the possibility of two "1 BAR" symbols on a single reel along with at least one other "1 BAR" [special] symbol on one of the other reels being displayed simultaneously (at rest condition). Additionally, there is the possibility of having more special or scatter symbols displayed than there are reels, at least for the reasons that Nagao discloses having at least 10 "1 BAR" symbols across the three reels, thus, even when implementing these reels on a 5 reel gaming machine, there is always the possibility that more special symbols will be displayed then there are reels (for at least claims 7 & 8).

Motivation to implement the reel strips of Nagao on the gaming machine of Yoseloff et al. comes from the simple concept that players of slot machines or gaming machines are more geared towards playing and continually playing gaming machines which provide for higher frequency and probability that a bonus award is going to be obtained. Thus, having a reel strip with more then one "special symbol" or "scatter symbol" in gaming machine of Yoseloff et al., provides a greater chance that a bonus round will be initiated, since the bonus rounds are initiated based upon a minimum number of "special symbols" that appear anywhere on the screen, along with desire to obtain a bonus game having an increased number of rounds, since Yoseloff et al. also disclose that the number of "special symbols" appearing anywhere on the screen determines the number of bonus rounds in the bonus game (column 3, line 66 – column 4, line 2 & column 4, lines 42-45, where "trigger symbols" are special or scatter symbols).

Therefore, it would have been obvious to one of ordinary skill at the time of the invention to modify Yoseloff et al. as taught by Nagao in order to provide a gaming machine that has an increased probability that a player will obtain "scatter" or "special" symbols and hence an award for scatter symbol combinations (i.e. at least three anywhere on the screen), making the gaming machine highly desirable to players.

Claim 2: Yoseloff et al. disclose the display means may be a video display unit, which would display simulated reels (column 3, lines 59-61).

Claims 3-5: As discussed above, the implementation of Nagao's reel strips into the gaming machine of Yoseloff et al. results in each of the reels having at least 2 occurrences of the "1 BAR" symbol. There is also at least one reel having 4 occurrences of the "1 BAR" symbol (figure 6A). Thus, it would be a mere design consideration by a game designer as to the number of certain symbols and their arrangement on the reel strip. Therefore, it would have been an obvious design consideration to a game designer at the time of the invention to design a reel for Yoseloff et al. or use Nagao's reels as described above so that each reel would incorporate more than one occurrence of a scatter symbol (claim 3), at least two scatter symbols (claim 4), or an arrangement in which up to three scatter symbols are able to be displayed together at any one time (i.e. displaying two satisfies the "up to 3" requirement) as taught by Nagao. The various implementations of more and more scatter symbols provides an additional increase in the probability that a higher total number of scatter or special symbols will be displayed on the reels, which is highly desirable to players.

Response to Arguments

Applicant's arguments filed August 1, 2007 have been fully considered but they are not persuasive.

The Applicant generally argues the combination of Yoseloff et al. & Nagao do not teach the claimed invention, see Applicant's remarks at pages 5-8 of the amendment filed August 1, 2007. In response, the Examiner respectfully disagrees with said arguments.

In response to applicant's general argument throughout the remarks, that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any

judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Thus, the Examiner submits that no improper hindsight reasoning was used in formulating the rejection of claims 1-8. The Examiner merely combined known elements and techniques to show that the combination of Yoseloff et al. & Nagao would have produced the claimed invention with predictable results. As discussed in the rejection, Yoseloff teaches scatter pays based on a minimum number of scatter symbols appearing anywhere on the screen (which does not necessarily preclude that multiple scatter symbols couldn't be on a single reel) and Nagao simply teaches an arrangement of reels where a particular symbol may be arranged in the claimed manner (where the 1-BAR symbol is replaceable with or able to be used as, a scatter or special symbol). Combining the two elements produces a straightforward invention, using no hindsight, with a plurality of scatter symbols stoppable such that more then one scatter symbol may be displayed on a single reel. The Applicant includes arguments directed to the process of determining the amount of scatter symbols, such arguments appear to pertain to pay table designing, which is a well known process in the art. Yoseloff et al. teach determining outcomes across vertical pay lines, thus, going one step further to determine multiple scatter symbols on a single reel would have required only routine skill in the art in designing the pay table to deal with any potential outcomes. Thus, it would have required only routine skill in the art to have implemented a pay table in view of the creation of a new invention having outcomes that did not fall under the current pay tables used. Designing a pay table is a known technique and to those of ordinary skill in the art would have been a common process to complete when designing any new gaming machine. Therefore, no unexpected results appear to arise from the claimed invention.

To those of ordinary skill in the art having the teachings of Yoseloff et al. and Nagao, it would have been an obvious matter of design choice or, likewise, it would have been obvious to try, because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. And, if this leads to the anticipated success, it is likely the produce is not of innovation but of ordinary skill and common sense (*KRS* analysis). Within the KRS decisions, the court has held that combining known elements or techniques of the prior art would be obvious to those skilled in the art, and only inventions that appear to produce unexpected results are pure innovation. Thus, as an alternative response, the Examiner submits that it would have been obvious to those of ordinary skill in the art to implement Nagao's known element of a reel strip having a particular symbol arranged in the claimed manner into Yoseloff et al. to produce an invention at least having multiple scatter symbols on a single reel, where it would have been an obvious design consideration to design the pay table around all possible outcomes. See also U.S. Patent No. 4,448,419 to Telnaes, which generally discloses the process/technique of designing a pay table.

Therefore, in response to the Applicant's general assertion that the claimed invention goes beyond merely adding more scatter symbols to some or all of the reels of the gaming machine to increase the frequency of scatter wins, the arguments are not persuasive.

For at least these reasons, the rejections are maintained above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing

date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Robert Pezzuto
Supervisory Patent Examiner
Art Unit 3714

M.B.S.